

REMARKS

Summary of the Office Action

In the Office Action, Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. 04-223875 (“JP’875”).

The Abstract, title, and claims 3, 4, and 8 were objected to for certain informalities.

Claims 1-9 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Summary of the Response to the Office Action

Applicant amends claims 1, 3-5, and 8-9 to better define the present invention and to address minor informalities. Applicant amends the Abstract and Title as suggested in the Office Action. Accordingly, claims 1-9 are pending and are submitted for further consideration. Applicant respectfully traverses these rejections and objections for the following reasons.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 1-9 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 1, 3, 4, 5, 8, and 9 have been amended to correct the ambiguities alleged in the Office Action. Applicant respectfully submits that claims 1, 3, 4, 5, 8, and 9 are in full compliance with 35 U.S.C. § 112, second paragraph. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies With 35 U.S.C. § 103(a)

Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *JP'875*.

Applicant respectfully traverses the rejection under 35 U.S.C. § 103(a) for the following reasons.

JP'875 shows a grindstone with a singular curved surface for grinding a lens. The grindstone rotates an abrasion layer across the curved lens. See the Abstract of *JP'875*.

The Office Action states that “the skilled artisan would appreciate that grindstone and whetstones are similar as they both are used to mechanically deform an object. It would have been obvious to one skilled in the art to utilize the process of *JP'875* to produce a whetstone with the expectation of obtaining similar results.” Applicant agrees with the Examiner that the terms are similar and states that the term whetstone, as used in the specification, is intended to include the meaning of the term grindstone. However, Applicant respectfully submits that the above-mentioned reasons are not evidence of obviousness and hence the Office Action has not established a *prima facie* case of obviousness. As such, all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

The Office Action has not established a *prima facie* case of obviousness at least because *JP'875* does not teach or suggest all the recited features of independent claim 1. Namely,

JP'875 does not teach or suggest at least “fixing plural base bodies on plural positions of a pedestal where at least one abrasive grain layer is formed,” features recited in claim 1. *JP'875* shows a grindstone with a singular curved surface for grinding a lens. Applicant respectfully submits that the Office Action does not address, teach, or suggest at least the “plural base bodies” features of the present invention, not shown in *JP'875*. See Fig. 1 and Abstract of *JP'875*.

As such, Applicant respectfully asserts that at least the third prong of *prima facie* obviousness has not been met. Accordingly, Applicant respectfully submits that independent claim 1 is allowable. Additionally, claims 2-9 are allowable at least because they recite the same combination of features as independent claim 1, as well as the additional features they recite that further distinguish them over the applied art. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this Response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Date: November 19, 2004

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MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			CHEN, BRET P	
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Please find below and/or attached an Office communication concerning this application or proceeding.

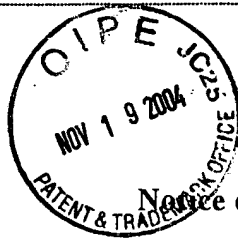
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Paper No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

- The amendment document filed on 10/22/4 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

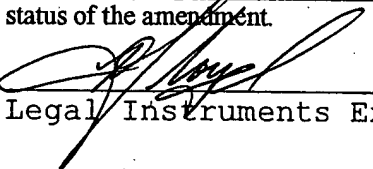
- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____
- ☐ 3. Amendments to the drawings: _____
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
 - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: Previously Amended is incorrect. Please see Revised Amendment Attachment

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.


Legal Instruments Examiner (LIE)

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